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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SPIEGEL, MICHAEL A

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 06/18/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/896,238

Applicant(s)

GRUNE ET AL.

Examiner

Michael A Spiegel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

DIANE DANZBAH
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "instantaneous" in claims 6,7,and 9 is a relative term which renders the claim indefinite. The term "instantaneous" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite

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degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In the computer arts, the term instantaneous is not clearly defined, as time scales vary greatly depending on the subject discussed. Something that appears instantaneous to a human user may in fact be billions of clock cycles old to the CPU. A more appropriate term is "real-time", which connotes that a user may perform a task and interact with the results of the task without undue delay.

Claims 8, 10, and 11 are rejected under USC 112, 2nd paragraph because these claims contain the rejected claim limitation of Claims 6,7, and 9.

Claim Objections

4. Claim 8 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7, 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivette et al. (US 5,991,751)

As to Claim 1, Rivette et al. teaches a computer system for enabling a simultaneous combination of techniques including intelligent searching for, problem solving with, and valuation of intellectual property, while providing model mapping of the techniques' results regarding the intellectual property in a meaningful manner with a user interface device, the computer system comprising;

at least one server computer (Fig. 3, 312);

one or more client computers connected to the server computer via a global area network (Fig. 3, 306A) and one or more computer programs executed by one or more server computers (Fig. 4, 410 & 416);

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wherein the computer program further comprises computer instructions for:

storing, retrieving, and searching for information regarding the intellectual property corresponding to a technology sector within a technology exchange in and from a database, storing, retrieving, and searching problem solving solutions related to the intellectual property in and from a database (i.e. R&D information, Fig. 2, 206), storing, retrieving, and searching scientific and engineering publications related to the intellectual property in and from a database (Fig. 4, 408);

allowing for searching, retrieving, and storing into and from the database or databases information regarding the intellectual property within the technology exchange, the problem solving database, and the science and engineering database, resulting in model mapping and valuing the intellectual property according to one or more search criteria specified by a user (Fig. 53; Fig 4, 408).

As to Claim 2, Rivette et al. teaches a system, wherein the intelligent searching includes accessing stored information contained within an electronic patent searching and retrieval system, an electronic patent valuation system, a science and

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engineering technology literature searching and retrieval system, and an engineering and science problem solving searching and retrieval system wherein the intelligent searching provides;

answers to queries regarding any aspect of the intellectual property, including instantaneous determination of a value of the intellectual property (i.e. search by fields, Fig. 12H; determining license revenue per patent, Fig. 12M) ;

determination of assignee or assignees (Fig. 12B, 1201);

determination of any prior art associated with the intellectual property (Fig. 12H, 1226);

determination of any inventors associated with the intellectual property (Fig. 12D, 1212);

determination of any patents and patent applications associated with the international and U.S. classification of the intellectual property where the property is itself a patent (i.e. search class, Fig. 12D, 1211),

determination of any past and current uses and users of the intellectual property (i.e. licensee, Fig. 12M);

prediction by the model mapping of a value, trend, or existence of current intellectual property and prediction by the model mapping of the value, trend or existence of future intellectual property (i.e. patent aging, financial functions,

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Col. 22, lines 66-67; Col. 23, lines 1-10).

As to Claim 3, Rivette et al. teaches a system, wherein any permutation and combination regarding techniques includes intelligent searching for (Fig. 53), problem solving with (i.e. concept searching, Col. 26, lines 29-33) , and valuation of intellectual property (i.e. patent licensing data, patent aging data, Fig. 67; Fig. 69), while providing model mapping of the intelligent searching and valuation results is optionally simultaneous and optionally includes a simpler combination of the techniques (i.e. multiple reports displayed simultaneously, Fig. 67. Note the standard Graphical User Interface which allows different reports to be selected either through a tab interface or tiled on the screen simultaneously, a standard feature of the "Window" menu.)

As to Claim 4, Rivette et al. teaches a system, wherein the combination of techniques including intelligent searching for, problem solving with, and valuation of intellectual property, while providing model mapping of the intelligent searching and valuation results is optionally simultaneous and optionally includes a simpler combination whereby only intelligent searching together with valuation of intellectual property while

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providing model mapping is provided (Fig. 70; Fig. 140. Note that the present invention allows concept searching in conjunction with patent aging and licensee searching.)

As to Claim 5, Rivette et al. teaches a system, wherein a second simpler combination includes problem solving using knowledge management based systems (i.e. advanced search techniques, Col. 26, lines 29-33) together with valuation of intellectual property based systems while providing model mapping (i.e. patent aging and licensee searching, Fig. 70).

As to Claim 6, Rivette et al. teaches a system, wherein a third simpler combination includes electronic patent searching and results of the searching for specific intellectual property (i.e. advanced search techniques, Col. 26, lines 29-33; Fig. 141) and simultaneous and instantaneous or near instantaneous valuation of the patented intellectual property while providing model mapping (i.e. patent aging and licensee searching and graphing, Fig. 70; Fig. 67).

As to Claim 7, Rivette et al. teaches a system, wherein a fourth simpler combination includes electronic non-patent searching and results of the searching for specific non-

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intellectual property (Col. 10, lines 17-22) and simultaneous and instantaneous or near instantaneous matching of the non-intellectual property with the patented intellectual property while providing model mapping (Fig. 80).

As to Claim 9, Rivette et al. teaches a computer implemented method for enabling optional simultaneous and instantaneous or optional simultaneous or optional instantaneous review of data containing files comprising;

patents, patent applications, and publications as they appear in an electronic patent shoe or otherwise, science and engineering technology literature pertinent to the patents and patent applications and publications from electronic databases (Col. 10, lines 8-14), and problem solving solutions pertinent to the patents and patent applications and publications from electronic databases (i.e. R&D information, Fig. 2, 206),

allowing for evaluation of the review and pertinent instant or near instant valuation methods of the patents or patent applications and publications comprising the steps of;

(1) causing generation of an electronic patent shoe with optional instant access to the science and engineering technology literature review, problem solving solutions review, and valuation methods comprising minimally a plurality of

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patents, and optionally the technology literature, and the problem solving solutions (i.e. document grouping, Fig. 4, 412; Col. 12, lines 43-67; Col. 13, lines 1-24);

(2) causing access to a user interface device to distribute, by means of an audio or visual or audiovisual display, in a meaningful manner, at least a list of patents and associated pertinent valuations of the list of patents in an instantaneous fashion and optionally allowing access and subsequent distribution to problem solving solutions and technology literature associated with and pertinent to the list of patents and associated valuations (i.e. user interface, Fig. 67; Fig. 70; Fig. 142);

(3) causing, pursuant to a command to view or hear a next file comprising the patents and associated valuations, the problem solving solutions and the technology literature, retrieval and audible or visual display of image or text data or both image and text data representative of at least a portion of the next file (Fig. 148, 14806); and

(4) causing, pursuant to a command to view or hear a previous file, retrieval and distribution of at least a portion of the previous file (i.e. next arrow, Fig. 148, 14806); and;

(5) allowing a user to scroll back and forth between steps (2) and (3) with no limitations and to provide reports with or

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without model mapping that capture any desired portion of the visual or audible or audiovisual displays (i.e. back arrow, Fig. 148, 14806).

As to Claim 10, Rivette et al. teaches a method comprising sequential steps of,

(1) causing generation of a problem solving solutions review with optional instant access to the science and engineering technology literature review, the electronic patent shoe, and the valuation methods comprising minimally problem solving solutions, and optionally the technology literature, and a plurality of patents (Col. 13, lines 25-44) and;

(2) causing access to a user interface device to distribute, by means of an audio or visual or audiovisual display, in a meaningful manner, at least a list of a problem solving solutions review of patents and associated pertinent valuations of the list of patents in an instantaneous or near instantaneous fashion and optionally allowing access and subsequent distribution to problem solving solutions and technology literature associated with and pertinent to the list of patents and associated valuations (i.e. user interface, Fig. 67; Fig. 70; Fig. 142), and;

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(3) causing, pursuant to a command to view or hear a next file comprising the solutions, the patents from the electronic patent shoes and the technology literature with the value of the patents retrieved from the electronic patent shoe based on the solutions, retrieval and audible or visual display of image or text data or both image and text data representative of at least a portion of the next file (Fig. 148, 14806); and

(4) causing, pursuant to a command to view or hear a previous file, retrieval and distribution of at least a portion of the previous file (i.e. next arrow, Fig. 148, 14806); and;

(5) allowing a user to scroll back and forth between steps (2), (3), and (4) with no limitations and to provide reports with or without model mapping that capture any portion of the visual or audible or audiovisual displays (i.e. back arrow, Fig. 148, 14806).

As to Claim 11, Rivette et al. teaches a method comprising sequential steps of;

(1) causing generation of a valuation of intellectual property with optional instant access to the science and engineering technology literature review, the electronic patent shoe, and the problem solving solutions review comprising minimally valuation solutions, and optionally the technology

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literature review results, electronic patent shoe searching results and problem solving solution results (Col. 13, lines 25-44);

(2) causing access to a user interface device to distribute, by means of an audio or visual or audiovisual display, in a meaningful manner, at least a list of associated pertinent valuations of the list of patents, a problem solving solutions review of patents in an instantaneous or near instantaneous fashion and optionally allowing access and subsequent distribution to problem solving solutions and technology literature associated with and pertinent to the list of patents and associated valuations (i.e. user interface, Fig. 67; Fig. 70; Fig. 142);

(3) causing, pursuant to a command to view or hear a next file comprising the valuations from the associated patents from the electronic patent shoes, associated problem solving solutions and associated technology literature, retrieval and audible or visual display of image or text data or both image and text data representative of at least a portion of the next file (Fig. 148, 14806); and

(4) causing, pursuant to a command to view or hear a previous file, retrieval and distribution of at least a portion of the previous file (i.e. next arrow, Fig. 148, 14806); and;

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(5) allowing a user to scroll back and forth between steps (2), (3), and (4) with no limitations and to provide reports with or without model mapping that capture any portion of the visual or audible or audiovisual displays (i.e. back arrow, Fig. 148, 14806).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Wilkinson (US 2002/0034695) teaches an intellectual property financial markets method and system.

Elliott (US 2001/0042034) teaches a method of repeatedly securitizing intellectual property assets and facilitating investments therein.

Donner (US 6,263,314) teaches a method of performing intellectual property audit optionally over network architecture.

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Eder (US 6,393,406) teaches a method of and system for valuing elements of a business enterprise.

Hagelin (US 2002/0077835) teaches a method for valuing intellectual property.

Barney et al. (US 6,556,992) teaches a method and system for rating patents and other intangible assets.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A Spiegel whose telephone number is 703-305-7605. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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Michael Spiegel

Michael Spiegel

Patent Examiner

Technology Center 2100

June 9, 2003

[Signature]
DIANE J. MIZRAHI
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100